

ESTTA Tracking number: **ESTTA800883**

Filing date: **02/13/2017**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|---|
| Name | The National Collegiate Athletic Association |
| Granted to Date of previous extension | 02/12/2017 |
| Address | P.O. Box 6222 Indianapolis, IN 46206 UNITED STATES |
| Attorney information | Douglas N. Masters Loeb & Loeb LLP 321 N. Clark Street, Suite 2300 Chicago, IL 60654 UNITED STATES chdocket@loeb.com, dmasters@loeb.com, eoneill@loeb.com, bfel-lars@loeb.com Phone:3124643100 |

Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 86923582 | Publication date | 08/16/2016 |
| Opposition Filing Date | 02/13/2017 | Opposition Period Ends | 02/12/2017 |
| Applicant | The Big Ten Conference, Inc. 5440 Park Place Rosemont, IL 60018 UNITED STATES | | |

Goods/Services Affected by Opposition


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|---|
| Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Promotional sponsorship of the presentation of athletic events and contests |
| Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Financial sponsorship of the presentation of athletic events and contests |
| Class 038. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Television transmission services for programming and content relating to sports; streaming of audio and video material on the Internet for programming and content relating to sports |
| Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Entertainment services, namely, coordinating the presentation of athletic events and contests; Entertainment services, namely, production and distribution of television programs relating to sports and sports entertainment; providing on-line information in the field of sports, television, video and audio entertainment via global communications network |

Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act Section 2(d) |
| False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute | Trademark Act Section 2(a) |
| Deceptiveness | Trademark Act Section 2(a) |

Marks Cited by Opposer as Basis for Opposition

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1571340 | Application Date | 03/09/1989 |
| Registration Date | 12/12/1989 | Foreign Priority Date | NONE |
| Word Mark | MARCH MADNESS | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 041. First use: First Use: 1986/03/10 First Use In Commerce: 1986/03/10 ENTERTAINMENT SERVICES, NAMELY, PRESENTATION OF ATHLETIC AND ENTERTAINMENT PERSONALITIES IN A PANEL FORUM | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2485443 | Application Date | 02/22/1993 |
| Registration Date | 09/04/2001 | Foreign Priority Date | NONE |
| Word Mark | MARCH MADNESS | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 041. First use: First Use: 1982/03/31 First Use In Commerce: 1982/03/31 entertainment in the nature of basketball tournaments between college teams | | |

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|-----------------------|---------------|-----------------------|------------|
| U.S. Registration No. | 3025527 | Application Date | 05/21/2004 |
| Registration Date | 12/13/2005 | Foreign Priority Date | NONE |
| Word Mark | MARCH MADNESS | | |

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|---------------------|---|
| Design Mark | MARCH MADNESS |
| Description of Mark | NONE |
| Goods/Services | <p>Class 009. First use: First Use: 1996/03/00 First Use In Commerce: 1996/03/00 [Computer game software and related instructional manuals and guides sold as a unit]</p> <p>Class 038. First use: First Use: 2001/03/00 First Use In Commerce: 2001/03/00 Telecommunications services; namely the transmission of voice, data, images, audio, video and information via local and long distance telephone, satellite and global computer networks; leasing telecommunications equipment, components, systems and supplies; electronic mail services; telephone voice messaging services; providing multiple-user access to global computer networks to transmit, receive and otherwise access and use information of general interest to consumers; web casting of athletic games, tournaments, exhibitions, and events via the Internet</p> <p>Class 041. First use: First Use: 1995/03/00 First Use In Commerce: 1995/03/00 providing sports information via the Internet</p> |

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| Attachments | 74360563#TMSN.png(bytes) 76593376#TMSN.png(bytes) Opposition.pdf(8316 bytes) |
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|-----------|----------------------|
| Signature | /Douglas N. Masters/ |
| Name | Douglas N. Masters |
| Date | 02/13/2017 |

In the matter of Application Serial No. 86/923,582: MARCH IS ON!
Published in the Official Gazette of August 16, 2016 in International Classes 35, 36, 38, and 41

NOTICE OF OPPOSITION

As grounds for opposition, Opposer alleges that:

2. Since long prior to February 29, 2016, the application date for MARCH IS ON!, Opposer has continuously used the MARCH MADNESS Mark in commerce in connection with, *inter alia*, sponsorship of athletic events, streaming and transmission of athletic events, and entertainment services.

3. The NCAA has registered its MARCH MADNESS Mark in the United States Patent and Trademark Office, including but not limited to, Reg. Nos. 1,571,340, 2,485,443, and 3,025,527.

4. These registrations are valid, subsisting and owned by the NCAA. These registrations are incontestable in accordance with 15 U.S.C. §§ 1065, 1115.

5. Opposer has offered/sold millions of dollars' worth of goods and services in connection with its MARCH MADNESS Mark.

6. Opposer has spent significant sums advertising and promoting its MARCH MADNESS Mark throughout the United States.

7. By virtue of the popularity of Opposer's goods and services offered in connection with the MARCH MADNESS Mark, and its advertising and promotion of the MARCH MADNESS Mark, Opposer has built up and now owns an extremely valuable goodwill which is symbolized by its MARCH MADNESS Mark.

8. On February 29, 2016, the Big Ten Conference, Inc. ("Applicant"), filed Application Serial No. 86/923,582 ("Application") with the United States Patent and Trademark Office seeking registration of the mark MARCH IS ON! for use with "promotional sponsorship of the presentation of athletic events and contests" in Class 35; "financial sponsorship of the presentation of athletic events and contests" in Class 36; "television transmission services for programming and content relating to sports; streaming of audio and video material on the Internet for programming and content relating to sports" in Class 38; and "Entertainment services, namely, coordinating the presentation of athletic events and contests; Entertainment services, namely, production and distribution of television programs relating to sports and sports

entertainment; providing on-line information in the field of sports, television, video and audio entertainment via global communications network” in Class 41.

9. Use by Applicant of MARCH IS ON! for the services set forth in the Application is likely to result in confusion, mistake, or deception with Opposer, or the goods and services marketed in connection with Opposer’s MARCH MADNESS Mark, or in the belief that Applicant or its MARCH IS ON! services are in some way legitimately connected with, or licensed or approved by, Opposer.

10. The proposed use by Applicant of MARCH IS ON! is without Opposer’s consent or permission.

WHEREFORE, registration by Applicant of the Application would be damaging to Opposer.

Date: February 13, 2017

LOEB & LOEB LLP

By: /s/ Douglas N. Masters
Douglas N. Masters
Elisabeth K. O’Neill
321 North Clark Street, Suite 2300
Chicago, Illinois 60654
Telephone: (312) 464-3100
Facsimile: (312) 464-3111
Email: chdocket@loeb.com, dmasters@loeb.com,
eoneill@loeb.com

Attorneys for Opposer